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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/770,942 | 01/25/2001 | Robert O'Brien | 3005-58065 | 8210 |

24197 7590 11/13/2002
KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

EXAMINER

POLITZER, JAY L

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2856

DATE MAILED: 11/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,942

Applicant(s)

O'BRIEN, ROBERT

Examiner

Jay L Politzer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-2, 4-8, 10-13, 87, 14, 17, 20, 18, 21-23, 25-27, 24, 28-36, 46-50, 52, 53, 51, 85, 68-84, 86, and 89-91; 37-39, 88, 40-42, and 45; 54-67 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, 4-8, 10-13, 87, 14, 17, 20, 18, 21-23, 25-27, 24, 28-36, 46-50, 52, 53, 51, 85, 68-84, 86, and 89-91 drawn to a method for analyzing a gas sample, classified in class 73 subclass 23.27.
- II. Claims 37-39, 88, 40-42, and 45 drawn to a method for analyzing an air sample in real time, classified in class 73, subclass 31.01.
- III. Claims 54-67, drawn to a gas chromatograph and gaseous sample analysis system, classified in class 73, subclass 23.24.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I. and II. are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I. has separate utility such as analyzing a gas sample, not necessarily in real time. See MPEP § 806.05(d).

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3. Inventions I. and III. are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because I. requires a chromatograph but not necessarily that of III. The subcombination has separate utility such as being useful without pneumatic focusing.

4. Inventions II. and III. are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because II. requires a chromatograph but not necessarily that of III. The subcombination has separate utility such as being useful without pneumatic focusing and not necessarily in real time.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species of the claimed invention in Group I.: a general gas sample, an air sample a breath sample, exhalation from a respiratory organism, air toxics, VOCs, OVOCs, metabolites, anesthetics, aqueous and gaseous components; continuous or discrete measurements; plural parallel or serial chromatographs; focusing-carrier gases of hydrogen, helium, nitrogen, argon, carbon dioxide, air and/or methane; reducing or increasing the pressure of the carrier-pneumatic focusing gas; simultaneously with or subsequent to sample injection; using a carrier gas or compressor; one or multiple carrier gases; using supercritical or non-supercritical carrier-gases; continuous or discontinuous gradient elution; detectors consisting of FID, IR, FTIR, NDIR, ECD, TCD, NPD, FPD, or UV/Visible; manual or automated operation; distributed pollution sources; sample preparation by filtering, absorption or vortexing; cryogenically liquefied samples; and making eddy correlation measurements to quantify fluxes. This application contains claims directed to the following patentably distinct species of the claimed

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invention in Group II.: continuous or discontinuous measurements; cryofocusing prior to or subsequent to pneumatic focusing; and cryogenically liquefied, or not. This application contains claims directed to the following patentably distinct species of the claimed invention in Group III.: a downstream or upstream detector; reducing the linear flow rate or increasing the linear flow rate; a sample amount that is less than or equal to a sample coil volume; single or plural columns and detectors; operation by a neural network or expert system; and a standard chromatograph or one on a microchip.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claim 1 is generic to Claim 37.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which

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are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. A telephone call was made to Mr. Slater on 9/20/02 and 9/25/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay L Politzer whose telephone number is 305-4930.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on 703-305-4705. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-4427 for regular communications and 703-308-7725 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4900.

JLP

November 4, 2002

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DANIEL S. LARKIN
PRIMARY EXAMINER

Continuation of Disposition of Claims. Claims pending in the application are 1-2, 4-8, 10-13, 87, 14, 17, 20, 18, 21-23, 25-27, 24, 28-36, 46-50, 52, 53, 51, 85, 68-84, 86, and 89-91; 37-39, 88, 40-42, and 45; 54-67.